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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,972	12/28/2000	Martin Karl Russel Burnham	GM10201-D1	7984

25308 7590 07/14/2004

DECHERT
ATTN: ALLEN BLOOM, ESQ
4000 BELL ATLANTIC TOWER
1717 ARCH STREET
PHILADELPHIA, PA 19103

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/14/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,972

Applicant(s)

BURNHAM ET AL.

Examiner

Manjunath N. Rao, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14 is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/28/00
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claims 11-22 are currently pending in this application which were suspended by the Examiner in view of a reference that was due to become available. The application has been removed from the suspended status as the reference has now become available. An Office action follows.

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on 11-6-01 is acknowledged.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Doucete-Stamm et al. (US 6,699,703). This rejection is based upon the public availability of a patent to another. Claims 15-22 of the instant application are drawn to a polynucleotide encoding a polypeptide comprising or consisting of SEQ ID NO:2, vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Doucete-Stamm et al. disclose a polynucleotide

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with SEQ ID NO:2480 that encodes a polypeptide (SEQ ID NO:5141) that is 100% identical to SEQ ID NO :2 (see enclosed sequence alignment) along with vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Therefore Doucete-Stamm et al. anticipate claims 15-22 as written.

Claims 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Barash et al. (WO 9818931-A2, 5-7-1998). This rejection is based upon the public availability of a publication. Claims 15-22 of the instant application are drawn to a polynucleotide encoding a polypeptide comprising or consisting of SEQ ID NO:2, vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Barash et al. disclose a polynucleotide which encodes a polypeptide that is 100% identical to SEQ ID NO :2 (see enclosed sequence alignment that is identical to that disclosed by Doucete-Stamm et al.) along with vectors and host cells comprising the same and a method of making said polypeptide using said host cells. Therefore Barash et al. anticipate claims 15-22 as written.

Allowable Subject Matter

Claim 11-14 are allowable.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 571-272-0939. The Examiner can normally be reached on 7.00 a.m. to 3.30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization

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where this application or proceeding is assigned is 703-872-9306 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

A handwritten signature in black ink, appearing to read 'Manjunath N. Rao', with a stylized flourish at the end.

Manjunath N. Rao
July 6, 2004

121 NQFATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDHLKKVROGYLSLDKE 180
DB 121 NQFATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDHLKKVROGYLSLDKE 180
QY 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212
DB 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212

RESULT 2

US-09-583-110-5141
Sequence 5141, Application US/09583110 → NOW US 6,699703B1.
GENERAL INFORMATION:
APPLICANT: Lynn Doucette-Stamm et al.
TITLE OF INVENTION: Nucleic Acid and Amino Acid Sequences Relating to Streptococcus
TITLE OF INVENTION: Pneumoniae for Diagnostics and Therapeutics
FILE REFERENCE: PAT00-07A
CURRENT APPLICATION NUMBER: US/09/583,110
CURRENT FILING DATE: 2000-05-26
PRIOR APPLICATION NUMBER: US 09/107,433
PRIOR FILING DATE: 1998-06-30
PRIOR APPLICATION NUMBER: US 60/085,131
PRIOR FILING DATE: 1998-05-12
PRIOR APPLICATION NUMBER: US 60/051,553
PRIOR FILING DATE: 1997-07-02
NUMBER OF SEQ ID NOS: 5322
SEQ ID NO 5141
LENGTH: 212
TYPE: PRT
ORGANISM: Streptococcus pneumoniae
US-09-583-110-5141

Query Match 100.0%; Score 1053; DB 19; Length 212;
Best Local Similarity 100.0%; Pred. No. 5.9e-100;
Matches 212; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
QY 1 MSKGFLVSLGPEGAGKTSVLEALLPILEKGEVLTTRPGGVLIGEKIREVILDPST 60
DB 1 MSKGFLVSLGPEGAGKTSVLEALLPILEKGEVLTTRPGGVLIGEKIREVILDPST 60
QY 61 QMDATTELLLYASRQHLVEKVLPALEAGKLYIMDRFTDSSVAYQGFGRGLDIEAIDWL 120
DB 61 QMDATTELLLYASRQHLVEKVLPALEAGKLYIMDRFTDSSVAYQGFGRGLDIEAIDWL 120
QY 121 NQFATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDHLKKVROGYLSLDKE 180
DB 121 NQFATDGLKPDILTYFDIEVEEGLIARIANSDBREVNRLDLEGLDHLKKVROGYLSLDKE 180
QY 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212
DB 181 GNRIVKIDASLPLEQVETTKAVLFDGMGLAK 212

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